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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,053	06/28/2000	Eric Lauzon	584-1027	5671

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William M Lee Jr  
Barnes & Thornburg  
P O Box 2786  
Chicago, IL 60690-2786

EXAMINER

HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 06/16/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/606,053

Applicant(s)

LAUZON ET AL.

Examiner

Ronald D Hartman Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments:*

1. As per claims 1 and 14, the applicant has argued that an email message is not equivalent to a signaling protocol message. However, the applicant then asserts that the signaling protocol for email messages is SMTP (See Remarks; page 6). Therefore, since SMTP is a signaling protocol, as admitted by the applicant, and since this signaling protocol uses an applet embedded in the message, as taught by Edwards, a feature wherein software code is used by the destination terminal in order that the software controls, wherein control is defined as, "an apparatus via which a user is able to receive communications from the network in order to be called by another party; i.e. a telephone handset, a computer or a mobile telephone" (See Remarks; page 6) is a feature that is adequately contemplated by Edwards since this is precisely the features that Edwards discloses.

2. The applicant then argues that the addition of the computer code allows a caller to have more control over a call to a destination terminal, such as "to clear the destination terminal so that an incoming may be received by the destination terminal" (See Remarks; page 8). The examiner notes that the rejection of claim 6, from which this particular argument originates, was not, as the applicant has mistakenly stated, rejected as being unpatentable over Edwards, but was actually rejected as being unpatentable over Edwards in view of Schuster, and therefore Schuster has been

applied to overcome the deficiencies of Edwards. In this instance, Schuster teaches many functions that may be entered as a feature of a SIP (session initiation protocol), and these features are believed to render the claimed features of having "a clearing of the destination terminal" unpatentable for at least the reasons as set forth in the previous office action.

3. The applicant then argues that claim 2 is not anticipated by way of its dependency on claim 1. Since the examiner does not agree with applicants arguments with respect to claim 1, as explained above, and since no further arguments were presented with respect to claim 2, the previous rejection of claim 2 is maintained.

4. The applicant then argues, with respect to claims 3-10, that Edwards does not teach software code to "configure" a destination terminal. However, it is noted that only claims 7-9 include explicit language regarding "configuration", per se, of the destination terminal. Therefore, this argument is not applicable to pending claims 3-6. Therefore, with respect to claims 7-9, the examiner respectfully disagrees, since as already explained above, "control of a destination terminal", as defined by way of the applicant (See above), is a feature that is contemplated by Edwards, and therefore Schuster is not needed to provide this particular feature, but rather, Schuster is applied to show the extent of typical known phone functions and how these functions would obviously be useful in a system, such as that taught by way of Edwards.

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5. The applicant then argues, with regards to claim 11, that one of ordinary skill in the art would not recognize the need for adding software code to a SIP message, nor to control a destination terminal using a SIP message. The examiner respectfully disagrees. Since Donovan and Edwards are directed to analogous art, that is they are both directed towards Ethernet type phones, and since Edwards clearly teaches the use of embedding functions within messages, as already explained above, and since SIP is a well known protocol used in IP telephony systems, as clearly taught by Donovan, the incorporation of Donovan into Edwards would have been obvious to one of ordinary skill in the art at the time the invention was made since it would form a more powerful and simple way in which control functions may be sent over a network, that is, as code contained within a message, so that the destination terminal may be controlled using the functionality represented by the code.

6. As per claim 15, the rejection of claim 2 (See previous office action and/or below) is applied equally herein.

Therefore, since the arguments were non-persuasive for the aforementioned reasons, and since the claims have not been amended to teach away from the prior art, this action is made **FINAL**, and the previous rejections are repeated herein for the applicant's convenience (labeled "maintained").

***Claim Rejections - 35 USC § 102 (maintained)***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Edwards et al., U.S Patent No. 6,502,127.

9. As per claim 1, Edwards teaches the claimed system of creating a message containing software code, and having this message transmitted to a destination terminal, where the code is executed to control a function of the destination terminal, as claimed by way of pending claims 1 and 14 (Claim 1).

10. As per claim 14, a client, arranged to receive the message, is inherent to Edwards (See Figure 1).

11. As per claims 2 and 15, Edwards clearly teaches an authorization step before executing the code in the message (Claim 4).

***Claim Rejections - 35 USC § 103 (maintained)***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, as applied to claim 1 above, and further in view of Schuster et al., U.S Patent No. 6,584,490.

14. As per claims 3-10, Edwards does not specifically claim the specific call control features, as claimed by claims 3-10.

Schuster teaches a plethora of call control features (C1 L27- C2 L49). The incorporation of these features, including priorities, voice mail routing, changing of operating parameters (configuration) and call forcing are all believed to be either taught by Schuster, or are at least obvious variations thereof, since they are all features that are for call control and therefore they would all provide for a more flexible telephone control system.

Therefore, since Schuster teaches the need for these call control features in an IP telephony system, and since Edwards teaches an IP telephony system, these particular features would obviously be effective for providing more control over the destination terminal, and therefore their incorporation into Edwards would be obvious since, at the very least, they would allow for simple, flexible and effective call control by

providing an abundance of call control features, and this would have been obvious at the time the invention was made.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Edwards, as applied to claim 1 above, and further in view of Donovan et al., U.S Patent No. 6,615,236.

As per claim 11, Edwards does not specifically teach an IP telephony system having SIP as its signaling protocol.

Donovan teaches SIP and the use of JAVA for an IP telephony system (e.g. Claim 1 and Abstract).

It would have been obvious to one of ordinary skill in the art at the invention was made to have incorporated call control for an IP telephony system, as disclosed by Edwards into the framework of SIP, as taught by Donovan since it would be easy to implement and debug, as disclosed by Donovan (C1 L41-44).

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the



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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is 703-308-7001. The examiner can normally be reached on Mon. - Fri., 11:30 am - 8:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.  
Examiner  
Art Unit 2121



Anthony Knight  
Supervisory Patent Examiner  
Group 3600